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Michael O'Doherty

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EXAMINER

JEAN GILLES, JUDE

ART UNIT

PAPER NUMBER

2143

NOTIFICATION DATE

DELIVERY MODE

12/12/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

## Office Action Summary

Application No.

09/520,853

Applicant(s)

O'DOHERTY, MICHAEL

Examiner

Jude J. Jean-Gilles

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 13, 19 is/are objected to.
- 8) ☒ Claim(s) 27-33 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other. \_\_\_\_\_

### **DETAILED ACTION**

This Action is in regards to the Reply received on 08/27/2007.

#### ***Response to Amendment/arguments***

1. This action is responsive to the replies filed on 08/27/2007. No claims were amended. Claims 1-26, and 34 are pending and represent a method and apparatus for "Session Initiation Protocol."

Applicant's arguments with respect to independent claims 1, 20, 24, 26, 27, 30, 31, 32, and 33 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the existing ground of rejection as explained here below. Applicant has made no amendments to the independent claims as to perhaps place them in condition for allowance.

The dependent claims stand rejected as articulated in the Previous Office Action and all objections not addressed in Applicant's response are herein reiterated.

In response to Applicant's arguments, 37 CFR § 1.11(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must show the amendments avoid such references or objections."

Applicant's Request for Reconsideration filed on 08/27/2007 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention:

A: Applicant contends that The Examiner states that ChaiTime discloses the step of storing computer software code in a SIP message. Applicant respectfully disagrees. ChaiTime discloses that when a particular service is required during a call "a specific MIME type, say "media/whiteboard", is used for the request" (P25 column 2). If a terminal component associated with the requested type is present on the receiving side then the call can be accepted "otherwise an attempt will be made to obtain a resource that can be associated with that MIME type, using dynamic service download" (P25 column 2).

B: Applicant argues that The Examiner further states that ChaiTime discloses "sending the SIP message and computer software code from the first SIP client associated with the first node to the second SIP client associated with the second node". Although ChaiTime does disclose transmitting the SIP message from the first SIP client to the second SIP client Applicant notes that the computer software code that is described in the SIP message is obtained using Dynamic Service Download where the first node "suggests a location on the internet where the software can be obtained" the second node then "downloads the software negotiating one-time use payment with the software provider if the software is not public-domain" (Page 22 Column 2).

C: Applicant submits that Schuster merely describes including a program that establishes connections for the purpose of sending Requests on an HSLIC and using this program to send traditional SIP messages. Nowhere does Schuster disclose or suggest including any programming code within a SIP message.

It is the position of the Examiner that ChaiTime in detail teaches the limitations of the above mentioned claims of the arguments. However, in view of Applicant's remarks, the Office respectfully concludes that the applicant fails to characterize the teachings in ChaiTime in the same way as the Examiner. ChaiTime discloses in fig. 3 of page 25 and Internet Telephony SIP/H323 Application whereas, one client communicates with each other via SIP message. In order to initiate a SIP message, an ordinary skill in the art knows that software code corresponding the identify of receiver and/or sender must be part of the message (*see also column 2, par. 2*). Furthermore, the patent of 6,567,399 of Schuster teaches "SIP includes messages necessary to identify user availability, user capabilities, call setup, and call handling.." (see Schuster, column 5, lines 45-65; column 7, lines 3-20). Thus identifying the user availability, user capabilities, call setup, and call handling.." entails the message storing software code that translates to this information.

Points B and C reiterate the same point of contention. The rejection is therefore sustained.

Examiner notes that applicant has failed in presenting claims and drawings that delineate the contours of this invention as compared to the cited prior art. Applicant has failed to clearly point out patentable novelty in view of the state of the art disclosed by the references cited that would overcome the 103(a) rejections applied against the claims, the rejection is therefore sustained.

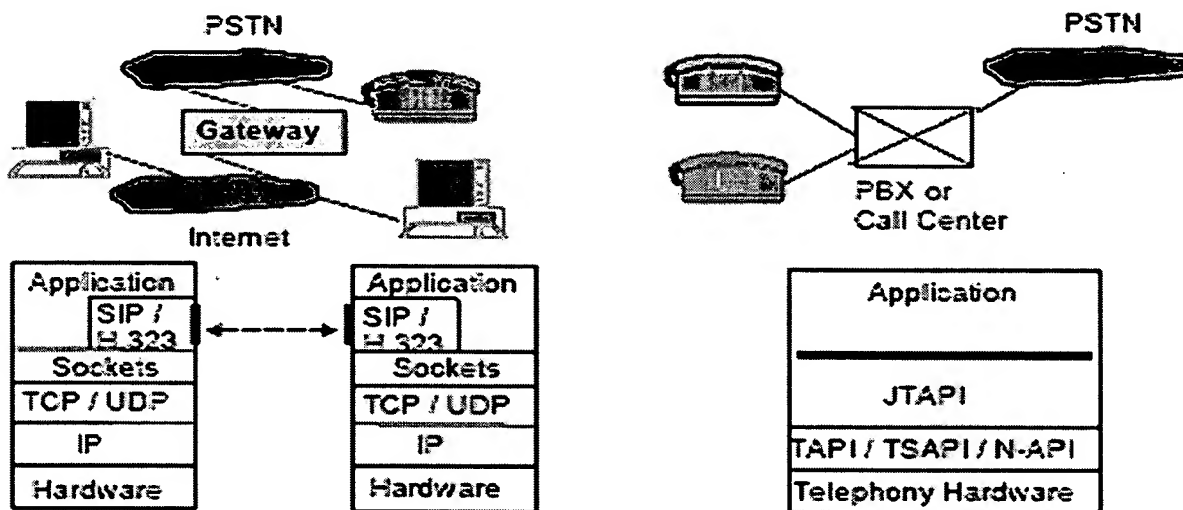
***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over "ChaiTime: A System for Rapid Creation of Portable Next -Generation Telephony Services Using Third-Party Software Components", (hereinafter ChaiTime), in view of Schuster et al (hereinafter Schuster), U.S. Patent No 6567,399 B1.

Regarding **claim 1**, ChaiTime teaches the invention substantially as claimed. ChaiTime discloses a method 1. A method of transferring computer software code between a first and a second node in a communications network, each of said nodes comprising a SIP client, said method comprising the steps of, i) storing computer software code in a SIP message; (Fig.3 of page 25, Internet Telephony SIP/H323 Application)



**Figure 3 Internet Telephony (IT) vs. Computer-Telephony Integration (CTI) approaches**

(ii) sending the SIP message and computer software code from the first SIP client associated with the first node to the second SIP client associated with the second node; (page 25, col.2, paragraph 2, "The issue of managing software components in ChaiTime is similar to that of managing applets and servlets in a Web based client-server environment ... if a Terminal Component is associated with the requested type, then the call can be immediately accepted and the component can be activated"; page 26, col. 1, second paragraph, The CTI approach is oriented towards developing portable software for applications such as call centers, PBXs, etc .... In contrast, the IT (Internet Telephony) approach (left side of Figure 3) is oriented towards developing protocols (e.g. SIP, H.323) that allow interoperability and communications between software running on user terminals or gateways"; Fig.4) and

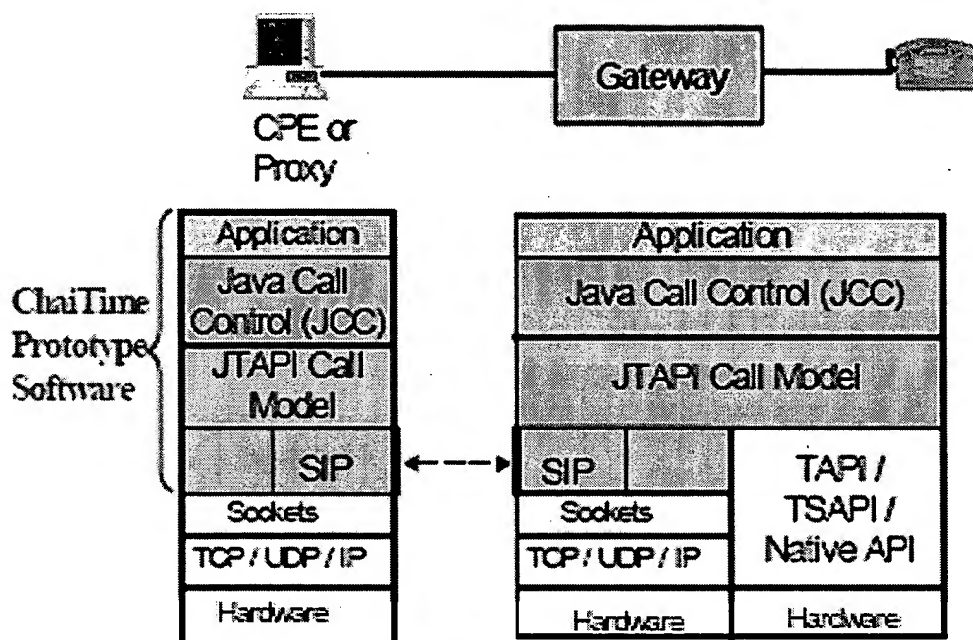


Figure 4 ChaiTime prototype software layers

(iii) executing the computer software using the second node. (page 26, col. 1, second paragraph, ...the IT (Internet Telephony) approach (left side of Figure 3) is oriented towards developing protocols (e.g. SIP, H.323) that allow interoperability and communications between software running on user terminals or gateway"; Fig.6, Message flow for dynamic service download).

However, in the reply dated 05/19/2006, applicants argue that ChaiTime does not disclose storing computer software code in a SIP message, it does not disclose sending the SIP message and computer software code from a first SIP client associated with a



first node to a second SIP client associated with a second node and it does not disclose the execution of computer software code transferred in the manner described above.

In the same field of endeavor, Schuster discloses a method in which "...  
...[see *Schuster*, column 8, lines 33-65] .

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Schuster's teachings of a method for storing code in a SIP message, with the teachings of ChaiTime, for the purpose of making available "a system that provides high-fidelity voice/audio transmission that overcomes the sound quality limitations associated with the existing PSTN communication system and existing VoIP systems" as stated by Schuster lines 60-64 of column 3. By this rationale **claim 1** is rejected.

Regarding **claims 2-12, 14-18, 20-26, and 34**, the combination ChaiTime-Schuster discloses:

2. A method as claimed in claim 1 wherein said computer software code is added to the SIP message. (see ChaiTime, See Java Telephony API, JTAPI Core Model, page 26, col.2)

3. A method as claimed in claim 1 wherein said step of storing computer software code in the SIP message comprises adding an address to the SIP message which indicates where the computer software is stored. (see ChaiTime, "Objects in the JTAPI core call model")

4. A method as claimed in claim 3 wherein said address is a universal resource locator (URL). (see ChaiTime, page 24, col.2, "The ChaiTime architecture is based on a network of distributed, interconnected Providers White Endpoints have a single logical address, ...domains, and provider network connectivity...")

5. A method as claimed in claim 1 wherein said computer software code comprises Java byte code. (see ChaiTime, JTPAI address - Java Telephony API; JCC - Java Call Control Model)

6. A method as claimed in claim 1 wherein said computer software code comprises one or more Java applets. (see ChaiTime, page 25, col.2, paragraph 2, "The issue of managing software components in ChaiTime is similar to that of managing applets and servlets in a Web based client-server environment ... if a Terminal Component is associated with the requested type, then the call can be immediately accepted and the component can be activated")

7. A method as claimed in claim 1 wherein said computer software code comprises one or more mobile automated software agents.

8. A method as claimed in claim 7 wherein said mobile automated software agents are Java mobile agents. (see ChaiTime, page 26, col. 1, see "ChaiTime call model")

9. A method as claimed in claim 1 wherein said second node comprises a Java virtual machine. (see ChaiTime, see "ChaiTime call model")

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10. A method as claimed in claim 2, wherein the computer software code, is added to the body of the SIP message. (see ChaiTime, page 26, col. 1, lines 1-29)

11. A method as claimed in claim 1, which further comprises adding an indicator to a header of the SIP message in order to indicate the presence of the computer software code and arranging the second SIP client to recognize the indicator. (see ChaiTime, page 26, col. 1, lines 1-29)

12. A method as claimed in claim 1 which further comprises the step of proceeding with any SIP process related to the SIP message. (see ChaiTime, page 26, col. 1, lines 1-29)

14. A method as claimed in claim 1, wherein said computer software is arranged to interact with the second SIP client vial a specified application programming Interface. (see ChaiTime, User A, User B)

15. A method as claimed in claim 1 wherein said computer soft-ware is arranged to interact with a processor associated with the second SIP client via a specified application programming interface. (see ChaiTime, page 26, col. 1, lines 1-29)

16. A method as claimed in claim 1 wherein said execution of said computer sot~are code causes the second node to set up a multimedia conference call. (see ChaiTime, page 28, col. 1, line 11-col.2, line 18)

17. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to upgrade or replace said SIP client. (see ChaiTime,

page 26, col. 1, lines 1-29)

18. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to test said second node to carry out a self-test function and to pass the results to another node. (see ChaiTime, as examiner's best understanding of claim 18; see page 26, col. 1, lines 1-29)

20. A communications network node comprising: (see ChaiTime, Claim 20 is similarly rejected as in claim 1) (i) a SIP client;  
(ii) an input arranged to receive SIP messages;  
(iii) a processor arranged to extract and execute-computer software code from a received SIP message.

21. A communications network node as claimed Java virtual machine. (ChaiTime system) in claim 20 wherein said processor comprises a

22. A communications network node as claimed in claim 20 which further comprises an application programming interface arranged to allow the computer software code to interact with the SIP client. (Claim 22 is similarly rejected as in claims 1-6)

23. A communications network node as claimed in claim 20 wherein said processor further comprises a detector arranged to detect an indicator in a received SIP message which indicates that computer software code is associated with that SIP message. (see ChaiTime, fig.7, State Machine of call events; EE1-EE8)

24. A computer program arranged to control a communications network node, said node comprising a SIP client and a processor, said computer program being arranged to

control the node when executed on the processor such that when a SIP message is received by the SIP client, which contains computer software code, the software code is executed by the processor. (Claim 24 is similarly rejected as in claim 1).

25. A computer program as claimed in claim 24 which is stored on a computer readable medium. (ChaiTime system)

26. A communications network comprising a plurality of communications network nodes each such node comprising:

- (i) a SIP client;
- (ii) an input arranged to receive SIP messages containing computer software code; and
- (iii) a processor arranged such that in use, when a SIP message is received, any computer software code contained in that SIP message is executed by the processor.

(Claim 26 is similarly rejected as in claims 1)

34. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to replace said SIP client [see Schuster, column 8, lines 33-65].

#### ***Allowable Subject Matter***

5. **Claims 13, and 19** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

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Jude Jean-Gilles

Patent Examiner

Art Unit 2143

October 29, 2007



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SUPERVISORY PATENT EXAMINER  
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